

affirmance of the Examiner's decision as a new ground of rejection under 37 CFR 1.196(b). (Decision, pp. 30-31). With respect to these rejections under 37 CFR 1.196(b), Applicant has elected by this Response to prosecute further before the Primary Examiner. The Response amends the drawings and includes a showing of facts not previously of record. It is believed that the amendments set forth in this Response will place the case in condition for allowance or, at least, in better form for appeal.

A. The 35 USC 112 Rejection, First Paragraph

The Board rejected the pending design claim under the first paragraph of 35 USC 112 because the design now claimed is distinctly different from the design shown and described in the application as originally filed. (Decision, p. 30). It was the Board's position that the then formal drawings (Appendix II) lack support for the shape of the flashlight head and certain additional features relating to (1) the depth of the recess in the end disc (Decision, pp. 19-20); (2) the size of the diameter of the central aperture in the end disc (Decision, p. 20); (3) the relative diameters of the end disc and the threaded portion of the flashlight housing (Decision, p. 21); (4) a beveled or conically shaped intermediate portion between the end disc and the threaded portion of the flashlight housing (Decision, p. 21) and (5) the textured mesh or net-like pattern of the central barrel portions

(Decision, p. 22).

1. The Flashlight Head Shape

The Board has held that with respect to the shape of the flashlight head, the deletion of the parting line which the Board designated as Bd1, is not supported by the original utility application. (Decision, p. 18). If the profile of the flashlight head shown in Figures 2 or 3 of the original utility application was defined by two intersecting straight lines, the Board would be correct in holding that the shape of the head is angled and requires the parting line Bd1 as shown in Figure 1 of the original utility drawings. However, if as Applicant contends, the profile of the head shown in Figures 2 or 3 of the original utility application includes a curved portion then the shape of the head in the present drawings are adequately supported by the original utility application and no parting line is required to be shown.

In reaching its decision, the Board did not address the overlay comparison submitted by the applicant as Exhibits I and II. Applicant submits that these Exhibits I and II establish that the head shape of the flashlight in the present drawings is the same as the head shape of the flashlight shown in Figure 2 or Figure 3 of the original utility application.<sup>1</sup>

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<sup>1</sup> It should be noted that the amended drawings submitted herewith have the same head shape as the previous drawings. (See the accompanying declarations of Fred R. McAlister, Robert Plumb

In addition to the above, evidence is submitted herewith which further establishes that the head shape of the flashlight shown in the present drawings is supported by the drawings of the original utility application. This additional evidence is set forth in the declarations of Martin J. Siegel and Jack B. Miller submitted in connection with Applicant's companion design application, Serial No. 410,965 and made a part hereof by the declaration of Robert C. Weiss.

Mr. Siegel has examined the profile of the head of the flashlight shown in Figure 2 of the original utility application and compared it with the same head shape shown in the present drawings.<sup>2</sup> Mr. Siegel has confirmed that the profile of the flashlight head shown in Figure 2 of the original utility drawings clearly includes a curved portion and is not defined by the intersection of two straight lines. (Siegel Declaration, paras. 8 and 9). Because the profile of the flashlight head includes a curved portion, it would be incorrect to show a parting line on the surface of the flashlight head (Siegel Declaration, para. 10). Mr. Siegel has also determined that the shape of the flashlight head

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and Robert C. Weiss.

<sup>2</sup> The shape or profile of the flashlight head shown in the drawings referred to in the Siegel and Miller declarations as the "present drawings" is the same as the shape or profile of the flashlight head shown in the amended drawings submitted herewith (See the accompanying declarations of Fred R. McAlister, Robert Plumb and Robert C. Weiss).

shown in Figure 1 of the original drawings is inconsistent with the shape of the flashlight head shown in Figures 2 or 3 of the original utility application. (Siegal Declaration, paras. 11 and 12).

Mr. Miller has also examined the shape of the flashlight head shown in Figure 2 of the original utility drawings and has determined that a person having ordinary skill in the art of flashlight design would recognize that the profile of the head shown in Figure 2 includes a curved portion and that Figure 2 supports the shape of the flashlight head shown in the present drawings. (Miller Declaration, para. 8). Because the head shape is curved, it would be incorrect to show a parting line on the surface of the head. (Miller Declaration, para. 9). Mr. Miller has also concluded that the shape of the flashlight head shown in Figure 1 of the original utility application would be recognized by a person having ordinary skill in the art of flashlight design as being inconsistent with the curved shape of the flashlight head shown in Figures 2 or 3 of the original utility application. (Miller Declaration, para. 10).

The Board also raised questions about the evidence submitted to the Board regarding the issue of whether the parting line shown in Figure 1 of the original utility application was

drawn in error.<sup>3</sup> (Decision, pp. 18-19). In this regard, Applicant submits the Declaration of Robert C. Weiss which includes the prior testimony of the attorneys involved in preparing the original utility application.

In support of its rejection under the first paragraph of 35 USC 112, the Board also asserted that there are additional design features which were shown or described in the pending design application which are not disclosed in either the first filed utility patent application, Serial No. 648,032 or any of the other utility patent applications in the copendency chain. These additional design features are discussed below.

## 2. THE END DISC RECESS

The first feature involves a recess in an end disc. The end disc has been designated Bd5 and Bd5a, respectively, and the recess Bd6 and Bd6a in the original utility drawings (Appendix I) and the then pending formal drawings (Appendix II). The Board asserts that, as compared to the shallow recess Bd6, an aperture or

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<sup>3</sup> Whether the parting line involves a drafting error is not decisive since, as indicated above, support for the present drawings is found in the other figures, namely Figures 2 and 3. As the Federal Circuit and the Board have held, support anywhere in the drawings and in whatever form is sufficient. Racing Strollers, Inc. v. TRI Industries, 11 USPQ 2d 1300, 1301 (Fed. Cir. 1989) and Ex Parte Asano, 201 USPQ 315, 318 (Bd. App. 1978). However, evidence of such an error further supports the conclusion that Figure 1 is inconsistent with Figures 2 and 3 of the original utility drawings.

deep well 6a without a bottom wall is shown in the Appendix II drawings. As a result, the bottom end of the bulb 45 could not be seen as it is seen in Figure 8 of the Appendix I drawings. This rejection has been fully overcome by the amended drawings submitted herewith which show a shallow recess with a bottom wall and an uncovered bulb. See the accompanying declaration of Fred R. McAlister, paragraph 14.

3. The End Disc Central Aperture Diameter

The next feature relates to the diameter of the central aperture of the end disc. The Board stated that the diameter of the central aperture Bd6a relative to the outer diameter of the end disc portion Bd5a in the design drawings (Appendix II) is significantly smaller than the diameter of the recess Bd6 relative to the outside diameter of end disc portion Bd5 in Figures 5 and 8 of the utility application or Appendix I drawings.

Applicant submits that this rejection has also been overcome by the amended drawings submitted herewith. These amended drawings show an end disc in which the diameter of the central aperture and the outer diameter of the end disc are proportionally the same as the diameter of the central aperture Bd6 and the outer diameter of the end disc Bd5 shown in Figure 8 of the original utility application drawings (Appendix 1). See the accompanying declaration of Fred R. McAlister, paragraph 15.

4. The Thread And End Disc Diameters

The next features concerns the outer diameter of the end disc as compared to the pitch or maximum diameter of the threaded portion of the flashlight housing or barrel. The Board has indicated that in Figures 5 and 8 of the original utility application drawings (Appendix I) the outer diameter of the end disc portion Bd5 is shown to be substantially the same as the pitch or maximum diameter of the threaded portion Bd8 and that in Figures 1 and 2 of the Appendix II drawings the diameter of the end disc portion Bd5a is significantly smaller than the pitch or maximum diameter of the threaded portion Bd6a.

Applicant submits that the Board is partially in error because as shown in Figure 5 of the Appendix I drawings, which is clearer than Figure 8 in this regard, the outer diameter of the disc is less than the maximum diameter of the threaded portion. See the accompanying declaration of Fred R. McAlister, paragraph 16. The amended drawing submitted herewith shows an end disc having an outer diameter which is like Figure 5 of the Appendix I drawings when compared to the outer diameter of the flat end of the barrel or flashlight housing.

5. The Barrel End Bevel

The Board also noted a difference between the barrel or flashlight housing and wall configuration in the Appendix II drawings and the Appendix I drawings. The Board stated that a beveled or conically shaped intermediate portion designated Bd9<sup>4</sup> in the Appendix II drawings between the threaded portion Bd8a and the end disc portion Bd5a is not found in the original utility application or Appendix I drawings. Applicant submits that the amended drawings submitted herewith fully overcome this rejection. See the accompanying declaration of Fred R. McAlister, paragraph 17.

6. The Barrel Mesh or Knurling

The final additional design feature on which the Board rejected the claim under the first paragraph of 35 USC 112 concerns the textured pattern of the barrel. The Board designated this pattern as Bd9 in Figures 1 and 2 in the Appendix II drawings.

The Board objected to the interstices of the pattern Bd9. The interstices previously selected were merely intended to be representative of a type of pattern on the barrel and its specific nature is not an essential element of the present invention.

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<sup>4</sup> The Board also designated what it refers to as the textured mesh as Bd9 in the Appendix II drawings. We believe that in this instance the Board is referring to the Bd9 designations in the upper part of the Appendix II drawings.

According to Mr. Miller, the exact nature of the interstices would not effect a change in the overall design of the present invention. (See the Declaration of Jack B. Miller, para. 15). However, in order to simplify the issues in this case, the drawings have been amended to show a pattern with a larger interstices. See the accompanying declaration of Fred R. McAlister, paragraph 18. Thus, there should be no objection to this pattern as shown in the present drawings submitted herewith.

7. The Threaded Portion Length and Diameter

In addition to the above features, the Board also agreed with the Examiner that the threaded portion Bd8a was changed in that the length and diameter of the threaded portion had been altered (Decision, p. 27). In the amended drawings submitted herewith the threaded portion of the barrel has been changed and the diameter and the length from the o-ring to the upper end of the barrel is in direct proportion to the same diameter and length shown in Figure 8 of the original utility or Appendix I drawings. See the accompanying declaration of Fred R. McAlister, paragraph 19.

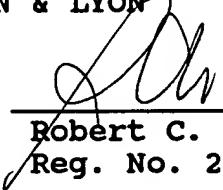
B. Conclusion

In view of the above, it is respectfully submitted that the application is now in condition for allowance.

Respectfully submitted,

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